REMARKS

Claims 1, 3-15, 17-29, 31, 33, and 38-40 are pending and stand finally rejected. Claims 1, 9, 18, and 25 are independent claims.

I.   THE 35 U.S.C. § 103 REJECTIONS OF CLAIMS 1, 3-16, 18-29, 31 AND 38-40

Claims 1, 4-5, 7, 9-12, 14, 18-20, 22, 24-28, 31 and 38-40 were rejected under 35 U.S.C. § 103 as being anticipated by Yoseloff et al. (U.S. Patent 6,464,581 B1)(hereinafter "Yoseloff") in view of Rudell *et al.* (U.S. Patent 6,200,219 B1) (hereinafter "Rudell")(see numbered par. 2-23 in Office Action). Reconsideration and withdrawal of this rejection is requested. Claims 3 and 16 were rejected under 35 U.S.C. § 103 as being unpatentable over Yoseloff in view of Rudell (see numbered paragraphs 24-25 in Office Action) were rejected under 35 U.S.C. § 103 as being unpatentable over Yoseloff in view of Rudell (see numbered paragraphs 24-25 in Office Action). Claims 6, 13, 21, and 29 were rejected under 35 U.S.C. § 103 as being unpatentable over Yoseloff in view of Rudell (see numbered paragraphs 26-27 in Office Action). Claims 8, 15, and 23 were rejected under 35 U.S.C. § 103 as being unpatentable over Yoseloff in view of Rudell (see numbered paragraphs 28-29 in Office Action). Reconsideration and withdrawal of these rejections is respectfully requested.

Yoseloff is alleges to disclose all of the limitations of claim 1, but is acknowledged to lack specificity as to a second discrete symbol being moved relative to the continuous graphical element and an award being determined based on the degree of movement relative of [*sic*] a payline." Rudell is cited as making up for this deficiency and is alleged to disclose "a video reel, wherein the processor is operable to, for at least one of the reels, move a second selected discrete symbol relative to the continuous graphical symbol and determine an award being related to a degree of the movement and being independent of any payline" (*citing* abstract, Figs. 1-3). In

particular, the Examiner notes that, in FIGS. 1-3, a vehicle moves relative to a graphical image 2, and that the "award indicated by speed, number of laps, and elapsed time" (*citing* FIG. 8, col. 4:27-35).

Applicant initially notes that Rudell does not disclose or suggest "a video reel," let alone a processor operable to move a selected discrete symbol relative to a continuous graphical symbol and to determine an award being related to a degree of the movement. Rudell discloses a non-wagering video game that is devoid of any "award." Rudell relates to toy vehicles with integral motion sensitive game displays. The Examiner's assertions that Rudell discloses an "award indicated by speed, number of laps, and elapsed time" (*citing* FIG. 8, col. 4:27-35) is incorrect and reflects an unreasonably broad interpretation of the claim language (i.e., "award"). Col. 4:27-35 states:

> Referring to FIG. 2, the video game may display data relating to the players performance of the game. For example, the game may display the "speed" of the vehicle image relative to the background image, along with the number of laps completed and an elapsed time. The game may have an input button (not shown) which allows the player to vary the skill level of the game. Varying the skill level may vary the software routine performed by the microprocessor 52.

Neither this passage nor the remainder of Rudell discloses or suggests an "award" indicated by speed, number of laps, and/or elapsed time. Instead, Rudell merely discloses a player's performance in a non-wagering game, such performance not being associated with any award. In contrast, the present application recites, in part, that "[a] payoff mechanism 24 is operable in response to instructions from the CPU 18 to award a payoff to the player in response to certain winning outcomes that might occur in the basic game or the bonus game" and that "[t]he payoff may be provided in the form of coins, bills, tickets, coupons, cards, etc.," the payoff amounts being "determined by one or more pay tables stored in the system memory 22." (see par. [0013] of US 2003/0087687). The "broadest reasonable interpretation" of the claims permitted by law

must be consistent with "the interpretation that those skilled in the art would reach." *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). In this vein, "[c]laims are not to be read in a vacuum, and limitations therein *are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'*." *In re Marosi*, 710 F.2d 799, 802, 218 USPQ 289, 292 (Fed. Cir. 1983)(*italics added*). It is submitted that one skilled in the art would not have reasonably interpreted "award" in the context of the claim and in light of Applicant's disclosure, as being a mere visual presentation of information on a display (e.g., display of a number of laps completed in a video game).

Moreover, it is noted that the Examiner premised the rejection, for all of claims 1, 4-5, 7, 9-12, 14, 18-20, 22, 24-28, 31 and 38-40, upon the argument that "the nudging of '581 for the player to obtain a more advantageous outcome (6:51-7:7) is analogous to the player control of the symbols (car) of '219 *as they are both using player input to control the motion of a symbol relative to a continuous graphical element to obtain a the [sic] most favorable outcome*" (*see* sentence bridging pages 3-4 of Office Action; *see also* the last sentence in each of numbered paragraphs 5, 6, and 7 of the Office Action)(emphasis added).

However, neither the disclosed invention nor the present claims permit "using player input to control the motion of a symbol relative to a continuous graphical element to obtain a the [*sic*] most favorable outcome." To clarify this point, the present claims have been amended to recite that "said processor is operable . . . to move a selected second discrete symbol relative to said continuous graphical element *independent of player control* to reveal a randomly determined outcome" (claim 1), "said processor is further configured . . . to move a selected second discrete symbol relative to said continuous graphical element *independent of player control* during a bonus game to represent, in association with a degree of movement of said selected second

discrete symbol and independent of any payline, a randomly determined outcome" (claim 9),

"conducting a bonus game responsive to a start-feature outcome in said basic game, said bonus

game comprising . . . moving in said bonus game a selected second discrete symbol relative to

said continuous graphical element *independent of player control* to display a randomly

determined outcome of said bonus game" (claim 18), and "conducting a bonus game responsive

to a start-feature outcome in said basic game, said bonus game comprising . . . moving in said

bonus game a discrete symbol between the adjacent ones of the discrete symbol positions as the

video reel is rotated to display a randomly determined outcome of said bonus game, *said moving

of said discrete symbol being independent of player control*" (claim 25)(emphasis added). As

disclosed in the Applicant's specification, "[t]he bonus game may be interactive and, for

example, prompt the player to select which dragster the player believes will win the drag race" or

that "[a]lternatively, the bonus game may merely depict the drag race without player interaction"

(see par. [0019]). The moving of the discrete symbol is, accordingly, independent of player

control, even though the player may be provided an option of selecting a desired discrete symbol

prior to the movement of the discrete symbol to reveal a randomly determined outcome

associated therewith.

Still further, the Examiner asserts that the advantage to the proffered combination, and

hence rationale for combination, of Rudell with Yoseloff "would be to provide greater

interactivity for the player as the racing car of '219 allows the player to control the racing of the

car (symbol) over a track (continuous graphical element), making '581 even more advantageous

for its intended purposes of some control over the outcome pertaining to the player." As noted

above and as clarified herein, the present claims do not permit the player of the wagering game

to "control" the discrete symbol during its movement relative to the continuous graphical

element. In view thereof, Applicant respectfully submits that the articulated reasoning of the Examiner lacks a rational underpinning to support the legal conclusion of obviousness under 35 U.S.C. § 103.

Further, in view of the Examiner's position that both Rudell with Yoseloff disclose "using player input to control the motion of a symbol relative to a continuous graphical element to obtain a the [*sic*] most favorable outcome" (*see* sentence bridging pages 3-4 of Office Action), Applicant respectfully submits that such assertion and alleged teaching constitutes a <u>teaching away from</u> the claimed invention, which explicitly recites that the movement of the discrete symbol relative to the continuous graphical element is independent of player control. In particular, based on the Examiner's admission, both Rudell and Yoseloff singly, and particularly in combination, would lead one of ordinary skill in the art in a direction divergent from the path that was taken by the applicant and would therefore be deemed to teach away from the claimed invention. *See, e.g., Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.* 73 F.3d 1085, 1090, 37 USPQ2d 1237, 1241 (Fed. Cir. 1995) (*quoting In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994)). Such evidence of teaching away constitutes evidence of <u>non-obviousness</u>. *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (CCPA 1978).

II. THE 35 U.S.C. § 103 REJECTIONS OF CLAIMS 17 AND 33

Claims 17 and 33 were rejected under 35 U.S.C. § 103 as being unpatentable over Yoseloff in view of Kojima (USP 5,265,889) (see numbered paragraphs 30-31 in Office Action). Reconsideration and withdrawal of these rejections is respectfully requested.

Further to the above remarks concerning Yoseloff, the Examiner acknowledges that the Yoseloff "lacks specificity as to a payout accumulating based on each discrete symbol position traveled by the discrete symbol." To make up for this deficiency, the Examiner alleges that Kojima, a handheld car racing game using a belt-like sheets 9 driven between two driving rolls 11, 12 (see FIG. 2), discloses "score accumulating based on the distance of a discrete symbol traveled in relation to a continuous graphical element" (citing col. 2, lines 53-58).

From this, the Examiner alleges that "[i]t would have been obvious . . . to apply the distance-based score accumulation of '899 to the game of '581".

As an initial matter, Applicant submits that claims 17 and 33 are patentable over the applied references for at least the reasons noted above with respect to base claims 9 and 25, such arguments being omitted herein for brevity.

Further, Applicant submits that Yoseloff discloses variants of basic wagering games, not bonus games. Yoseloff discloses that "[t]he provision of all of the symbols on a single continuous stream or strip of virtual information, as opposed to the provision of the symbols on streams for individual, separately rotated virtual reels, fundamentally alters the nature of the mathematics and the structure of the mathematics used in the formulation of the games and therefore further distinguishes this format from all previous formats for play of video reel slot games." (col. 7, lines 16-23). Yoseloff further discloses that "[i]n the practice of the present invention, the frequency is based upon a fundamentally different principle than either mechanical or virtual reel slots" (col. 7, lines 38-40). The example cited by the Examiner (FIG. 5), as well as the example shown in FIG. 4, represent basic wagering games wherein a plurality of elements are aligned relative to one or more pay lines based on the randomly determined outcome of the game. Since the base wagering game utilizes a continuous strip, and all of the frames are fixed

relative to one another, incorporation of an extra "distance-based score accumulation" as advanced by the Examiner would fundamentally impact the underlying mathematics of the game disclosed by Yoseloff and could very well render it unfit for its intended purpose. The object of FIG. 5 of Yoseloff is to register place frames of the box cars 91 relative to the paylines A-C. Due to the nature of Yoseloff's continuous reel, "[a]ll of the frames and their specific position on the video screen will always be the same when that specific image and frame (e.g., the seventh occurrence of King Kong in the continuous loop) appears." (col. 7, lines 53-56). Thus, to alter a distance of the line of train cars would cause a corresponding change in the position of the cars relative to the paylines and would therefore change the outcome. Accordingly, introduction of the asserted "distance" variable to Yoseloff would fundamentally change the mathematics of the underlying game (e.g., hit frequency could decrease significantly in the basic wagering game) and correspondingly, fundamentally alter the "playability" of the game. Gaming regulations may also include prohibitions of certain alterations of the mathematics, which would have to be considered (see, e.g., Yoseloff col. 8, lines 63-66))(i.e., gaming regulation compliance may certainly teach away from certain modifications to the mathematics of slot machine wagering games and must be considered if such an assertion related to mathematics is to be elevated from a mere conclusory statement to an articulated reasoning with some rational underpinning, which would support a legal conclusion of obviousness). Thus, the assertion that "[t]he advantage of this combination would be to provide a further way for a player to accumulate points, as opposed to merely winning points for winning paylines" is unsupported by any evidence of record and is, moreover, incorrect, as Yoseloff is not concerned with "points," but credits having a monetary value associated therewith, which are governed by the game mathematics, which in turn, are strictly controlled by the gaming regulations of the various jurisdictions permitting gambling.

The Examiner must show reasons <u>why</u> a skilled artisan, confronted with the same problems as the inventor and with <u>no</u> knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). The showing must be clear and particular. See, e.g., *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). This burden has not been discharged by the Examiner.

III. CONCLUSION

The Applicants believes the claims are in condition for allowance, and action towards that end is earnestly solicited.

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number shown. No fees are believed due in connection with this amendment. The Commissioner is, however, authorized to deduct any necessary fees (except for payment of the issue fee), from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000119USPT.

Respectfully submitted,

Date: October 15, 2007
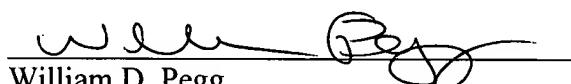
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